



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/847,796	05/02/2001	Vijay Mayadas	13372-103	4898
26486	7590	12/07/2004	EXAMINER	
PERKINS, SMITH & COHEN LLP ONE BEACON STREET 30TH FLOOR BOSTON, MA 02108			DIXON, THOMAS A	
		ART UNIT		PAPER NUMBER
				3629

DATE MAILED: 12/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/847,796	MAYADAS, VIJAY	
	<b>Examiner</b>	<b>Art Unit</b>	
	Thomas A. Dixon	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 02 May 2001.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-14 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-14 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 02 May 2001 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>1/02</u>	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

## DETAILED ACTION

### ***Claim Interpretation***

1. Claims directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959).

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987). Thus the structural limitations of claim 10, including an information server, a payment server and a network; as per claim 11 a profile manager are disclosed in Dedrick as described herein. Also as described the limitations of the claim do not distinguish the claimed apparatus from the prior art.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-7, 10-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Dedrick (5,234,521).

As per claim 1.  
Dedrick discloses

Art Unit: 3629

publishing information from a targeted message sponsor at an access point provided by a publisher on a network connected to the targeted message system, see figure 7b (218), and

providing a first payment to the publisher of said information in response to user interaction with said published information at said access point, see figures 7a (214) and 7b (224).

As per Claim 2.

Dedrick further discloses determining if a user interacting with said published information is a qualified user, see figure 7a (208), and

if said user is qualified, providing a second payment to said qualified user in response to said user interaction, see figure 7b (218).

As per Claim 3.

Dedrick further discloses determining if a user has a profile, see figure 7a (208).

As per Claim 4.

Dedrick further discloses matching the user profile to a target profile, see figure 7a (206, 208).

As per Claim 5.

Dedrick further discloses publishing a target message, see figure 7b (218).

As per Claim 6.

Dedrick further discloses the targeted message is an advertisement, see figure 7a (214).

As per Claim 7.

Dedrick further discloses a question answered by the user, see column 4, lines 30-48.

As per Claim 10.

Dedrick discloses:

an information server, see figure 1 (14, 18, 20), and  
a payment server, see figure 1 (14) and figure 3 (37) and figure 4 (53); and  
a network; see figure 1 (10),

the other limitations are seen to be non-functional descriptive material and intended use and do not distinguish the claimed apparatus from the prior art.

As per claim 11.

Dedrick further discloses a profile manager see figure figure 2 (29, 27),

the other limitations are seen to be non-functional descriptive material and intended use and do not distinguish the claimed apparatus from the prior art.

As per claim 12-14.

The other limitations are seen to be non-functional descriptive material and intended use and do not distinguish the claimed apparatus from the prior art.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dedrick (5,234,521) in view of Official Notice.

As per Claim 8.

Dedrick further discloses a network, see figure 1 (10), but does not disclose the network is the Internet.

Official Notice is taken that the Internet is an old and well known network.

LeMole et al, Hanson et al, Angles et al or Goldhaber each teach the use of the internet for targeted advertising for the benefit of reaching a large audience.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to use the Internet in the invention of Dedrick for the benefit of reaching a large audience.

As per Claim 9.

Dedrick further discloses a network, see figure 1 (10), but does not disclose the use of escrow accounts.

Official Notice is taken that the escrow accounts are an old and well known accounting vehicle.

Abecassis teaches targeted advertising, payments, and use of escrow accounts for accounting, column 36, lines 40-48, column 48, lines 52+56, and column 49, line 63 – column 50, line 10 for the benefit of compensating viewers for viewing targeted messages.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to use escrow accounts in Dedrick as an old and well known accounting vehicle.

***Prior Art Made of Record***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

WO 98/34189 to Roth et al is the closest foreign art that teaches targeted advertising on the internet.

Gallagher et al "A framework for Targeting Banner Advertising on the Internet" is the closest NPL that teaches targeted advertising on the Internet.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Dixon whose telephone number is (703) 305-4645. The examiner can normally be reached on Monday - Thursday 6:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thomas A. Dixon  
Primary Examiner  
Art Unit 3629